

FPW/A

PATENT
ATTORNEY DOCKET: 46884-5389

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Fumitsugu FUKUYO, et al.) Confirmation No.: 4722
Application No.: 10/537,511) Group Art Unit: 2873
Filed: November 28, 2005) Examiner: Scott J. Sugarman
For: LASER PROCESSING APPARATUS)

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Window, Mail Stop Amendment
Alexandria, VA 22314

Sir:

RESPONSE AND REQUEST FOR RECONSIDERATION
TRANSMITTAL FORM

1. Transmitted herewith is an Amendment in response to the Office Action dated March 17, 2008.
2. Additional papers enclosed:
 - ☒ Verified English-language translation of Japanese priority document (Japanese Patent Application No. P2002-354234)
 - ☐ Form PTO-1449
 - ☐ Citations
 - ☐ Declaration of Biological Deposit
 - ☐ Submission of "Sequence Listing", computer readable copy and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence.

3. Extension of Time

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136(a) apply.

☐ Applicants believe that no extension of time is required. However, this conditional petition is being made to provide for the possibility that Applicant has inadvertently overlooked the need for a petition and fee for extension of time.

☒ Applicant petitions for an extension of time, the fees for which are set out in 37 C.F.R. § 1.17(a), for the total number of months checked below:

<u>Total Months Requested</u>	<u>Fee for Extension</u>	<u>[Fee for Small Entity]</u>
<input type="checkbox"/> one month	\$ 120.00	\$ 60.00
<input checked="" type="checkbox"/> two months	\$ 460.00	\$ 230.00
<input type="checkbox"/> three months	\$ 1,050.00	\$ 525.00
<input type="checkbox"/> four months	\$ 1,640.00	\$ 820.00

Extension of time fee due with this request: \$ _____

If an additional extension of time is required, please consider this a Petition therefor.

☐ An extension for _____ months has already been secured and the fee paid therefor of _____ is deducted from the total fee due for the total months of extension now requested.

4. Constructive Petition

☒ **EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

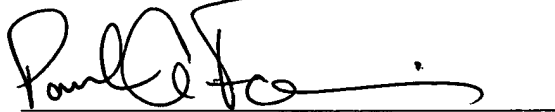
5. Fee Calculation (37 C.F.R. §1.16)

CLAIMS AS AMENDED						
	Claims Remaining After Amendment		Highest No. Previously Paid	Present Extra	at Rate of	Total Fees
Total Claims (37 C.F.R. §1.16(c))	5	minus	20	0	x \$50 each =	+ \$0.00
Independent Claims (37 C.F.R. §1.16(b))	2	minus	3	0	x \$200 each =	+ \$0.00
[] First presentation of Multiple dependent claim(s)					\$360.00	+ \$0.00
SUB-TOTAL =						\$0.00
Reduction by ½ for filing by a small entity						- \$0.00
TOTAL FEE =						\$0.00

6. Fee Payment

- ☐ No fee is to be paid at this time.
- ☒ Enclosed is a check in the amount of \$ 460.00 for the 2-month extension of time fee.
- ☐ The Commissioner is hereby authorized to charge _____ to Deposit Account No. 50-0573 for the _____ fee.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, including fees due under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account 50-0573.

Respectfully submitted,

DRINKER, BIDDLE & REATH LLP


By:

Paul A. Fournier

Registration No. 41,023

Dated: August 14, 2008

Customer No. 055694

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Sir:

RESPONSE AND REQUEST FOR RECONSIDERATION

In response to the non-final Office Action dated March 17, 2008, the period for response to which runs through August 18, 2008, (August 17, 2008 being a Sunday) by the currently-filed petition for a two-month extension of time and corresponding fee payment, reconsideration and withdrawal of the outstanding rejections are respectfully requested in light of the following remarks:

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REMARKS**Rejections under 35 U.S.C. § 103(a)**

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Imakado et al. (U.S. Patent No. 7,151,788) (hereinafter "Imakado"). With regard to these rejections, Applicants respectfully submit that Imakado should not be considered as prior art in the present application under any subsection of 35 U.S.C. § 102.

Acknowledgement of a Claim for Priority and of receipt of a certified copy of the instant application's priority document (Japanese Patent Application No. P2002-354234, which was filed in Japan on December 5, 2002) was made by the Examiner at page 1, section 12 of the Office Action dated March 17, 2008. Pursuant to 37 C.F.R. § 1.55(a), Applicants submit concurrently herewith a verified translation of Japanese Patent Application No. P2002-354234. The effective U.S. filing date under 35 U.S.C. § 102(e) of Imakado is December 24, 2002, which is after the priority date to which this application is entitled.

Accordingly, Applicants respectfully submit that Imakado should not be considered as prior art in the present application under any subsection of 35 U.S.C. § 102. As all of the rejections under 35 U.S.C. § 103(a) apply Imakado, withdrawal of all of these rejections is thus respectfully requested.

Objection to Claim 4

Claim 4 stands objected to under 37 C.F.R. § 1.75 as allegedly "being a substantial duplicate of claim 3." This objection is respectfully traversed for at least the

following reasons. The Examiner generally cites to 37 C.F.R. § 1.75 and MPEP § 706.03(k) in this regard but gives no particular evidence of how the Examiner has reached the conclusion that the features described in claims 3 and 4 of the instant application are substantially duplicates of each other.

Applicants respectfully submit that claims 3 and 4 have been closely reviewed and, while they may repeat some of the same features, these claims are not substantially identical to each other to any extent. For example, Applicants respectfully submit that claim 3 relates to a situation where the laser light emitted from the beam expander is divergent light. On the other hand, Applicants respectfully submit that claim 4 relates to a situation where the laser light emitted from the beam expander is convergent light. Accordingly, Applicants respectfully submit that claims 3 and 4 are not substantially identical to each other.

In addition, each of the respective claims 3 and 4 of the instant application are in proper format as these claims are not word-for-word duplicates of each other. To any extent that two claims are similar to each other, but are not “word-for-word” duplicates of each other, Applicants understand that the standard application of claim differentiation principles of U.S. patent law apply to such claims.

Finally, MPEP § 706.03(k) specifically directs that “court decisions have confirmed applicant’s right to restate (i.e., by plural claiming) the invention in a reasonable number of ways.” This section of the MPEP goes on to even further direct that “a mere difference in scope between claims has been held to be enough.”

Accordingly, in the event that the Examiner might choose to maintain this objection, the Examiner is respectfully requested to explain why these portions of MPEP § 706.03(k) do not apply in this instance.

Withdrawal of the objections to claims 3 and 4 are thus respectfully requested for at least the foregoing reasons.

The Office Action dated March 17, 2008 Does Not Address Claim 5

Applicants respectfully submit that a new independent claim 5 was added to this application in a Preliminary Amendment filed on November 28, 2005. However, the Office Action dated March 17, 2008 does not appear to have addressed this independent claim to any extent. Accordingly, confirmation of allowability of independent claim 5 is respectfully requested in the next Office Communication. However, if the Examiner deems that a rejection of independent claim 5 is appropriate, Applicants respectfully request that any such rejection of independent claim 5 not be made final in the next Office Communication as the claim has not yet been rejected in the instant application. See 37 C.F.R. § 1.113 and MPEP § 706.07. Regardless, the Examiner is respectfully requested to address independent claim 5 in the next Office Communication.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after

consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

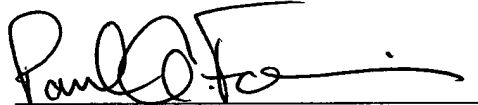
If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0573. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

DRINKER, BIDDLE & REATH, LLP

Dated: August 14, 2008

By:



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Registration No. 41,023

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